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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,944	08/30/2002	Dante Monteverde	33983/400100	3631

27717 7590 07/06/2004

SEYFARTH SHAW  
55 EAST MONROE STREET  
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CHICAGO, IL 60603-5803

EXAMINER
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NGUYEN, CINDY

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/064,944	MONTEVERDE, DANTE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cindy Nguyen	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2002.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/02/03</u> <u>05/08/03</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is in response to application filed on 11/08/2000 in which claims 1-13 are presented for examination.

#### **1. *Information Disclosure Statement***

The information disclosure statement filed on 05/02/03, 05/08/03 are in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Because it has been placed in the application file, and the information referred to therein has been considered as to the merits.

#### **2. *Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (U.S 2002/0099700) in view of Zimmermann et al. (U.S 6678694) (Zimmermann).

Regarding claim 1, Li discloses: method of predicting the search needs of a computerized database search user comprising the steps of: providing a topical category database (page 6, paragraph 0066, Li), said topical category database containing a plurality of topical categories (page 6, paragraph 0066, Li);

relating each of said topical categories with other said topical categories contained within said topical category database (page 6, paragraph 0066, Li);

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providing a document database, said document database having document information for at least one document (page 6, paragraph 0067, Li);

receiving at least one initial search term (page 6, paragraph 0064, Li);;

matching said initial search term with at least one said anticipated search term contained within said anticipated search term database thereby creating a matched search term (page 6, paragraph 0065, Li);

associating said initial search term to any topical categories related to said initial topical category thereby creating related categories (page 6, paragraph 0066-0067, Li).

However, Li didn't disclose: assigning each of said documents to at least one said topical category; providing an anticipated search term database, said anticipated search term database having at least one anticipated search term; assigning each of said anticipated search terms in said anticipated search term database to at least one said topical category thereby creating an anticipated search term assignment; associating said initial search term with the topical category assigned to said matched search term thereby creating an initial topical category. On the other hand, Zimmermann discloses: assigning each of said documents to at least one said topical category (col. 7, lines 14-40, Zimmermann); providing an anticipated search term database, said anticipated search term database having at least one anticipated search term; assigning each of said anticipated search terms in said anticipated search term database to at least one said topical category thereby creating an anticipated search term assignment (col. 7, lines 63 to col. 8, lines 38, Zimmermann); associating said initial search term with the topical category assigned to said matched search term thereby creating an initial topical category (col. 7, lines 25-40, Zimmermann). Thus, at the time invention was made, it would have

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been obvious to a person of ordinary skill in the art to include the steps for assigning each of documents and providing an anticipated search term database and creating an initial topical category in the system of Li as taught by Zimmermann. The motivation being enable the method assign topics to documents manually, is not to define extremely narrow topics which are then assigned to a very limited number of documents, and analysis procedure searches for these same word and adjacent or neighboring searchable words within the same document (topical category) (col. 1, lines 1 to col. 8, lines 38, Zimmermann).

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Li/Zimmermann discloses: further comprising the step of retrieving said document information of said documents assigned to said related categories (page 6, paragraph 0065, Li).

Regarding claim 3, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Li/Zimmermann discloses: where each said topical category is defined with a title and description (page 5, paragraph 0058, Li).

Regarding claim 4, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Li/Zimmermann discloses: wherein the step of relating each of said topical categories with other said topical categories contained within said topical category database further comprises the step of relating each of said topical categories with other relevant topical categories (page 5, paragraph 0057-0058, Li).

Regarding claim 5, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Li/Zimmermann discloses: wherein the step of

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relating each of said topical categories with other said topical categories contained within said topical category database further comprises the step of relating each of said topical categories with other related topical categories (page 5, paragraph 0057-0058, Li).

Regarding claim 6, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Li/Zimmermann discloses: wherein the step of relating each of said topical categories with other said topical categories contained within said topical category database further comprises the step of relating each of said topical categories with other adjunct topical categories (page 6, paragraph 0066, Li).

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Li/Zimmermann discloses: wherein the step of assigning each of said documents to at least one said topical category further comprises the step of assigning each of said documents to a relevant topical category (col. 7, lines 25-40, Zimmermann).

Regarding claim 8, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Li/Zimmermann discloses: wherein the step of assigning each of said anticipated search terms in said anticipated search term database to at least one said topical category thereby creating an anticipated search term assignment further comprises the step of assigning each of said anticipated search terms to a topical category based on said anticipated search term's definition (col. 7, lines 63 to col. 8, lines 38, Zimmermann).

Regarding claim 9, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Li/Zimmermann discloses: wherein the step of

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associating said initial search term with the topical category assigned to said matched search term thereby creating an initial topical category further comprises the step of calculating the most popular initial topical category for said matched search term (page 4, paragraph 0052, Li).

Regarding claim 10, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Li/Zimmermann discloses: wherein the step of calculating the most popular initial topical category for said matched search term further comprises the step of calculating the number of times a topical category is selected by other searchers in association with each said initial search term used (page 7, paragraph 0067, Li).

Regarding claim 12, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Li/Zimmermann discloses: further comprising the step of subjectively determining said most popular initial topical category (page 6, paragraph 0066, Li).

Regarding claim 13, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Li/Zimmermann discloses: wherein said initial search term comprises at least one word (page 6, paragraph 0066, Li).

**4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li (U.S. 2002/0099700) in view of Zimmermann et al. (U.S. 6678694) (Zimmermann) and further in view of Mallon et al. (U.S. 2003/0047781) (Mallon).**



Regarding claim 11, all the limitations of this claim have been noted in the rejection of claim 9 above. However, Li/Zimmermann didn't disclose: further comprising the step of calculating the number of times said initial search term is repeated within the content of said document assigned to said topical category. On the other hand, Mallon discloses further comprising the step of calculating the number of times said initial search term is repeated within the content of said document assigned to said topical category (page 5, paragraph 0044, Mallon). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the step for calculating the number of times said initial search term in the combination system of Li/Zimmermann as taught by Mallon. The motivation being enable a method calculates the a search request in the form of a search phrase containing one or more search terms, counted by search term, e.g., count the number of times "ford" or "sports" was used as a search word in a search phase (page 5, paragraph 0044, Mallon).

### **5. Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Cindy Nguyen

June 29, 2004



WAYNE AMSBURY  
PRIMARY PATENT EXAMINER